

CC



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,096	02/15/2001	Kazuhiro Kusuda	Q63180	4487

7590 11/01/2002

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
 2100 Pennsylvania Avenue, N.W.
 Washington, DC 20037

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,096

Applicant(s)

KUSUDA, KAZUHIRO

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 14, & 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation, "comprising a game value adding device which adds a game value in accordance with a result of the race." How is this value determined? And to what is it added?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19, & 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fongeallaz et al. (US Patent Number 5,186,460)

Claims 1, 8, 15: Fongeallaz teaches a game system with a racing field formed on a predetermined board (Fig 13) that is electronically displayed on a screen. There is a running model to which an inherent ability parameter varying in accordance with a given environment is assigned. (Col 5, 41-45) The racing field (Fig 13) comprises a plurality of field regions (squares in Fig 13) in which the running model runs based on a current

Art Unit: 3714

ability parameter in accordance with the respective field region. (Col 5, 40-56) These field regions clearly exist concurrently on the same game board. (Fig 13)

Claims 2, 3, 9, 10, 16, 17: Fongeallaz describes a steeplechase game in which there are flat regions where the running model performs steady running in which the current ability parameter is maximized and in other regions there is a region formed so as to obstruct the steady running (obstacles). (Col 5, 63-66)

Claims 5, 12, 19: Each of the small squares depicted in Figure 13 is a field region. These field regions clearly exist concurrently on the same game board. (Fig 13) A passageway is formed between the plurality of field regions so that the running model can enter and exit, and the same running model can run races on the plurality of field regions. Fig 13 depicts a race between running models H1-H4. As clearly depicted in the figure, the running models enter and exit the various field regions and run races on a plurality of field regions.

Claims 6, 13, 20: The plurality of field regions for concentric racing courses. (Col 4, 36-43)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 11, 18, & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz as applied to claims 1, 8, or 15 above (as appropriate).

Claims 4, 11, & 18: Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62) For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col (Col 5, 43-45) While Fongeallaz does not specifically teach dirt and turf track sections, these are the two main types of tracks used in horseracing. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used dirt track and turf track sections in order to simulate the two main track types used in horseracing.

Claim 22: Fongeallaz teaches a game system with a racing field formed on a predetermined board (Fig 13) that is electronically displayed on a screen. There is a running model to which an inherent ability parameter varying in accordance with a given environment is assigned. (Col 5, 41-45) The racing field (Fig 13) comprises a plurality of field regions (squares in Fig 13) in which the running model runs based on a current ability parameter in accordance with the respective field region. (Col 5, 40-56)

Fongeallaz also teaches use of a track with regions having different attributes. (Col 5, 40-62) Fongeallaz teaches adjusting the condition of the soil in the region simulating the dirt course by use of dry track and mud track attributes. (Col (Col 5, 43-45) While Fongeallaz does not specifically teach both dirt and turf track sections, these are the two main types of tracks used in horseracing. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used dirt track and turf track sections and adjusting the condition of the soil or turf (respectively) in order to simulate the two main track types used in horseracing under differing conditions.

Art Unit: 3714

7. Claims 7, 14, 21, & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongellaz as applied to claims 1, 8, 15 or 22 above (as appropriate), and further in view of Ikeda et al. (US Patent Number 6,371,854).

Claims 7, 14, 21, & 23: Fongellaz teaches the invention substantially as claimed.

Fongellaz teaches storing a “library” of data concerning the attributes and abilities of each running model. (Col 5, 50-62) Fongellaz does not, however, specifically teach adding a game value to the “library” in accordance with the result of the race. Ikeda, a game in the same art, teaches allowing players to raise and train their own horses (running models). This training includes running races and recording the result of the race in the horse’s library of information. Allowing players to raise and train their own horse gives the player a greater sense of involvement in the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have added a game value to the horse’s “library” of attributes in accordance with the result of the race in order to allow the player to raise and train the horse, thus giving the player a greater sense of involvement in the game.

8. Applicant's arguments filed 19 August 2002 have been fully considered but they are not persuasive.

9. With respect to the rejection of claims 7, 14 & 21 under 35 USC §112, 2nd paragraph, Applicant has failed to particularly point out which game value is to be added. The limitation, “a game value” is broad and amorphous. It could be virtually anything. In order to overcome this rejection, a more descriptive term should be used or greater detail should be added to describe how this “game value” is determined.

Art Unit: 3714

10. With respect to the rejection of claims under 35 USC §102 & §103, Applicant argues that Fongeallaz does not anticipate/teach the claimed invention because Fongeallaz fails to teach multiple tracks with different characteristics. This argument is not commensurate with the scope of the claims. The claims are drawn to a plurality of field regions existing on the same board. Fongeallaz's Fig 13 clearly shows a plurality of field regions existing on the same board – each square is a region. While Applicant's disclosure may be enabling for a dirt track and a turf track on the same board, Applicant has failed to claim this. (It should also be noted that Filiczowski (US Patent Number 5,106,098), which is prior art of record in the case, clearly teaches the concept described in Applicant's argument in Fig 1B.)

11. In response to applicant's argument in regard to claims 7, 14, 21 & 23 that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Fongeallaz teaches storing a library of data concerning attributes and abilities of each running model. The Fongeallaz reference makes it clear that the attributes listed are not exhaustive. (Col 5, 50-62) Ikeda is an analogous invention. It too is a racing game. Ikeda teaches allowing players to raise and train their own horses (running models). This training includes running races and recording the result of the race in the horse's library of information. Allowing players to raise and train their own horse gives the player a greater sense of involvement in the game. It would have been

Art Unit: 3714

obvious to one of ordinary skill in the art at the time of the invention to have added a game value to the horse's "library" of attributes in accordance with the result of the race in order to allow the player to raise and train the horse, thus giving the player a greater sense of involvement in the game.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

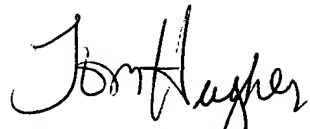
Art Unit: 3714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc

October 29, 2002



S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700